



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,281	05/15/2001	Takenori Kohda	JP920000095	1913

7590

03/14/2006

Robert W. Griffith
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560

EXAMINER

BATURAY, ALICIA

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,281

Applicant(s)

KOHDA ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the amendment filed 22 December 2005.
2. Claims 1-22 are pending in this Office Action.

Response to Amendment

3. The rejection of claims 9, 21 and 22 under 35 U.S.C. § 101 were addressed and are withdrawn.
4. The rejection is respectfully maintained as set forth in the last Office Action mailed on 19 September 2005. Applicant's arguments with respect to claims 1-22 have been fully considered but they are not persuasive and the old rejection maintained.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 16, 17 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
7. With respect to claims 16 and 17, the claimed invention is directed to non-statutory subject matter. The claim recites "...an object management means" which is not defined either in the claim or in the specification as including hardware. Thus, absent recitation of the

server or some other hardware, claim 16 is not limited to tangible embodiments, instead being sufficiently broad to encompass software, per se. Claim 17 fails to add any additional structure to the system, instead merely further limiting the intended use of the system. Thus, it fails to overcome the deficiencies of claim 16.

8. With respect to claim 20, the language of the claim appears to be drawn to non-functional descriptive material. An "object" as recited in claim 20 is data, per se, lacking any functionality. Even if the object was amended to include functional code, claim 20 fails to tangibly embody the object, so it would still be non-statutory. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 88 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law. See MPEP § 2106 and the Interim Guidelines.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miles et al. (U.S. 6,102,406) in view of Kay (WO 00/41067).

Miles teaches the invention substantially as claimed including a new advertising model requiring a user to traverse through an authorized path including at least one predetermined web address (See Abstract, and col. 2, lines 5-10).

11. With respect to claim 1, Miles teaches a user guidance method performed on a computer comprising the steps of:

Incorporating an object into a specific web site at a specific location, where the object is capable of being selected by a user (Miles, col. 10, lines 45-49) in order to provide a reward for the user (Miles, col. 11, lines 1-5); where at least one user desiring to select the object is guided to predetermined content available at the specific web site (Miles, col. 3, lines 35-38).

Miles does not explicitly teach moving the object.

However, Kay teaches an object that appears on a web site that can be selected and takes the user from the specific location to a different location (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

12. With respect to claim 2, Miles teaches the invention described in claim 1, including the user guidance method where the step of moving the object comprises the step of:

Incorporating the object into the specific web site at the different location, after the object has been selected by the user (Miles, col. 10, line 64-col. 11, line 1).

13. With respect to claim 3, Miles teaches the invention described in claim 1, including the user guidance method further comprising the step of:

Providing information, after incorporating the object, concerning the location of the object for the at least one user desiring to select the object (Miles, col. 10, lines 5-8).

14. With respect to claim 4, Miles teaches the invention described in claim 1, including the user guidance method where at the step of moving the object, the user is moved along a predetermined route, and the at least one user desiring to select the object is guided to predetermined content in accordance with a specific order based on the route (Miles, col. 4, lines 48-57).

Miles does not explicitly teach moving the object.

However, Kay teaches an object that is moved (Kay, page 3, line 25 – page 4, line 27).

Art Unit: 2155

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

15. With respect to claim 5, Miles teaches the invention described in claim 1, including the user guidance method where at the step of incorporating the object, the object is incorporated at specific locations at multiple connected web sites across a network (Miles, col. 3, lines 26-31).

Miles does not explicitly teach moving the object.

However, Kay teaches where at the step of moving the object, the object is moved across the network (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

16. With respect to claim 6, Miles teaches the invention described in claim 5, including the user guidance method where at the user is moved along a predetermined route across the multiple web sites on the network (Miles, col. 4, lines 48-57), and the at least one user desiring to select the object is guided to predetermined content available in a specific sequential order based on the route (Miles, col. 4, lines 48-57).

Art Unit: 2155

Miles does not explicitly teach moving the object.

However, Kay teaches where at the step of moving the object, the object is moved across multiple web sites on the network (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

17. With respect to claim 7, Miles teaches a computer-based content advertisement method comprising the steps of:

Incorporating an object into a network among content multiple users desire to browse, where the object is capable of being selected by a user (Miles, col. 10, lines 45-49) in order to provide a reward for the user (Miles, col. 11, lines 1-5), and when a predetermined user browses the content, where a user desiring to select the object, is guided to and enabled to browse the content and additional content (Miles, col. 10, lines 24-27).

Miles does not explicitly teach moving the object.

However, Kay teaches moving the object in the network among additional content multiple users desire to browse (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

18. With respect to claim 8, Miles teaches the invention described in claim 7, including the content advertising method (Miles, col. 1, lines 43-45) where incorporating an object into a network among content multiple users desire to browse, where the object is capable of being selected by a user (Miles, col. 10, lines 45-49).

Miles does not explicitly teach moving the object.

However, Kay teaches where at the step of moving the object, movement of the object is effected along a route that includes the content multiple users desire to browse (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

19. With respect to claim 9, Miles teaches a computer-based user guidance system comprising:

A server comprising: an object manager for managing the location and movement of an object on a network (Miles, col. 13, lines 36-46); a position information generator for generating information concerning the location of the object, and for providing the information to a user who is accessing the network (Miles, col. 10, lines 5-8); and a processor for, when the object is selected by a predetermined user (Miles, col. 11, lines 1-5), performing a predetermined process associated with the object selection, where the object

Art Unit: 2155

manager arranges the object at a desired location in order to guide the user to desired content on the network (Miles, col. 10, lines 14-49).

20. With respect to claim 10, Miles teaches the invention described in claim 9, including the user guidance system where, when the object is selected, the processor transmits a notification to that effect to the object manager, and upon the receipt of the notification (Miles, col. 10, line 64 – col. 11, line 1).

Miles does not teach deletion and repositioning of another object.

However, Kay teaches the object manager deletes the object selected by the user, and positions another object at a different location on the network (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

21. With respect to claim 11, Miles teaches the invention described in claim 9, including the user guidance system where, when the object is selected by a specific user, the processor transmits, together with information concerning the specific user, a notification to that effect to the object manager; where, upon the receipt of the notification, the object manager manages the information concerning the specific user, who is regarded as the person who has selected the object (Miles, Fig. 5, element 32; col. 10, line 64 – col. 11, line 1); where, if the

Art Unit: 2155

object is selected by multiple users, only the specific user is regarded as the person who has selected the object (Miles, col. 12, lines 30-35).

22. With respect to claim 12, Miles teaches a computer-based object control system comprising:

Web servers, for storing web pages (Miles, Fig. 3, element 26); and a main server, for communicating with a predetermined web server (Miles, Fig. 3, element 20).

Miles does not explicitly teach moving the object.

However, Kay teaches where the main server incorporates a specific object into a first specific web page and removes the specific object from a second specific web page stored in the specific web server (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

23. With respect to claim 13, Miles teaches the invention described in claim 12, including the object control system where the object is selected when the object is present in a web page that a user is currently browsing (Miles, col. 10, lines 45-49); and where, when the object is selected by the user (Miles, col. 11, lines 1-5).

Miles does not teach deletion and repositioning of another object.

However, Kay teaches the main server deletes the object from the web page and incorporates the object into another web page (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

24. With respect to claim 14, Miles teaches the invention described in claim 12, including the object control system where the main server provides, for the user who accesses the specific web server, information concerning the location of the object that is appearing (Miles, col. 10, lines 5-8).

25. With respect to claim 15, Miles teaches the invention described in claim 14, including the object control system where the information concerning the location of the object, which is provided for the user, indicates the ease with which the object can be reached from the web page browsed by the user (Miles, col. 15, lines 59-61).

26. With respect to claim 16, Miles teaches an object control system of a computer comprising:

An object management means for managing the location of the object on the network, where the object management means changes the location of the object on the network in order to move the object across the network (Miles, col. 13, lines 36-46).

Miles does not explicitly teach embedding the object into a web page.

However, Kay teaches an object to be embedded in a web page stored at a web site on a network (Kay, page 4, lines 22-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable embedding the object into a web page. One would be motivated to do so in order to facilitate promoting purchases from an Internet web site.

27. With respect to claim 17, Miles teaches the invention described in claim 16, including the object control system where the object management means correlates the location of the object with a web page browsed by a predetermined user, and changes the location of the object when web pages are browsed by the predetermined user (Miles, Fig. 5, element 32; col. 10, line 64 – col. 11, line 1).

28. With respect to claim 18, Miles teaches a computer-based object control system comprising:

An object stored in a predetermined server (Miles, Fig. 5, element 36); and object position management means, for determining a web page for setting a link thereto, where, under the control of the object position management means the link setting means changes a target web page for setting a link thereto (Miles, col. 13, lines 36-46).

Miles does not explicitly teach moving the object.

However, Kay teaches link setting means, for setting a link in a web page stored at a web site on the network in order to move to the object (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

29. With respect to claim 19, Miles teaches the invention described in claim 18, including the object control system where the object position management means defines a web page browsed by a predetermined user as the target web page to which the link with the object is to be set, and changes the target web page as the predetermined user browses the web pages; and where the link setting means, under the control of the object position management means, changes the link with the object (Miles, col. 10, line 45 – col. 11, line 1).

30. With respect to claim 20, Miles teaches an object whose location on the network is managed by specific management means, and which moves from a predetermined web page to another web page, where the object is capable of being selected by a user (Miles, col. 10, line 45 – col. 11, line 1) in order to provide a reward for the user (Miles, col. 11, lines 1-5).

Miles does not explicitly teach moving the object.

However, Kay teaches a moving object (Kay, page 3, line 25 – page 4, line 18), to be embedded in a web page stored at a web site on a network (Kay, page 4, lines 22-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

31. With respect to claim 21, Miles teaches a storage medium on which input means of a computer stores a program in an input-enabled form, the program causing the computer to perform:

A process for incorporating a specific object into a specific web page stored in a specific web server; a process for, when a user browses the specific web page and selects the specific object (Miles, col. 10, line 64-col. 11, line 1).

Miles does not explicitly teach moving the object.

However, Kay teaches moving the object to another web page (Kay, page 3, line 25 – page 4, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

32. With respect to claim 22, Miles teaches a program transmission apparatus comprising:

Storage means for storing a program that causes a computer to perform: a process for incorporating a specific object into a specific web page stored in a specific web server, a

Art Unit: 2155

process for, when a user browses the specific web page and selects the specific object and transmission means for reading the program from the storage means and for transmitting the program (Miles, col. 10, line 64-col. 11, line 1).

Miles does not explicitly teach moving the object.

However, Kay teaches moving the object to another web page (Kay, page 3, line 25 – page 4, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

Response to Arguments

33. Applicant's arguments filed 22 December 2005 have been fully considered, but they are not persuasive for the reasons set forth below.
34. ***Applicant Argues:*** Applicant states "Applicant asserts that a claim directed to software does not in itself constitute non-statutory subject matter."

In Response: The examiner respectfully submits that when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). See MPEP § 2106 and the Interim Guidelines.

35. ***Applicant Argues:*** Applicant states "that no motivation or suggestion exists to combine Miles and Kay in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. In the Office Action, on page 5, paragraph 1, the Examiner provides the

Art Unit: 2155

following statement to prove motivation to combine Miles and Kay, with emphasis supplied:

‘It would have been obvious...to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.’ Applicants submit that the statement above is based on the type of ‘subjective belief and unknown authority’ that the Federal Circuit has indicated provides insufficient support for an obvious rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.”

In Response: The examiner respectfully submits that in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation statement of “One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser” can be found in the Kay reference on page 3, lines 25-28. This renders the rejection proper, and thus rejection stands.

36. ***Applicant Argues:*** Applicant states “Applicants do not believe that Miles and Kay are combinable since it is not clear how one would combine them. No guidance was provided in the Office Action as to how the references can be combined to achieve the present invention.”

In Response: The examiner respectfully submits that in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references are directed to a method of driving customers to view advertisers' websites (“In this new advertising model, the hosting site sponsors a treasure or scavenger hunt in which participants are asked to provide answers to questions. The intent of the hosting site operators is to direct participants to advertiser Web sites in order to locate answers to those questions” – see Miles, col. 2, lines 5-10; and “The present invention relates to a method and apparatus for stimulating or encouraging a potential customer viewing a web site on the Internet to purchase goods or services on the web site” – see Kay, page 1, lines 7-10). The motivation statement to combine these references of “One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser” can be found in

Art Unit: 2155

the Kay reference on page 3, lines 25-28. This renders the rejection proper, and thus rejection stands.

37. ***Applicant Argues:*** Applicant states “The combination of Miles and Kay also fails to disclose the moving of the object as recited in independent claims 1 and 7.”

In Response: The examiner respectfully submits that Kay teaches an object that appears on a website that can be selected (overlaying on a web page, a button icon which is adapted to be activated by the customer when the customer desires to purchase a product or service) and takes the user from the specific location to a different location (when activated, the button icon will send the customer via a link to a separate page or window where an order form will be provided on which the customer indicates or confirms the product or service to be ordered – see Kay, page 3, line 25 – page 4, line 27). This renders the rejection proper, and thus rejection stands.

38. ***Applicant Argues:*** Applicant states “The combination of Miles and Kay fails to disclose an object manager that manages the location and movement of an object on a network and arranges the object at a desired location to guide the user to the desired content on the network, as described above with regard to claim 1.”

In Response: The examiner respectfully submits that Miles teaches an object manager for managing the location and movement of an object on a network (this table may include the URL of at least the first Web site where the first game question/clue set (and possibly answer) can be found. This table can be expanded with additional URL locations as needed by the game – see Miles, col. 13, lines 36-46), where the object manager arranges the object at a desired location in order to guide the user to desired content on the network (for example, in one embodiment the introductory question/clue set for a game may inform the participants that the question will be related in some way to a particular book (identified in a clever way, perhaps not readily apparent to all participants...By visiting the Amazon.com Web site and searching for the subject book, the participants are required to become familiar with that site in an effort to locate the answer...Then, by clicking on a hidden (or not) hyperlink on that page of the Amazon.com site (e.g., a hyperlink hidden behind an image of the subject book or perhaps prominently displayed on the page if the advertiser so chooses) the participant is returned to the game site – see Miles, col. 10, lines 14-49). This renders the rejection proper, and thus rejection stands.

39. ***Applicant Argues:*** Applicant states “The combination of Miles and Kay fails to disclose a main server that incorporates the object into a first web page and removes the object from a second web page.”

In Response: The examiner respectfully submits that Kay teaches a main server

incorporates a specific object into a first specific web page (overlying on a web page, a button icon which is adapted to be activated by the customer when the customer desires to purchase a product or service) and removes the object from a second web page (when activated, the button icon will send the customer via a link to a separate page or window where an order form will be provided on which the customer indicates or confirms the product or service to be ordered – see Kay, page 3, line 25 – page 4, line 27). This renders the rejection proper, and thus rejection stands.

40. ***Applicant Argues:*** Applicant states “The combination of Miles and Kay fails to disclose the changing of the location of the object on the network in order to move the object across the network, as described with regard to claim 1.

In Response: The examiner respectfully submits that Miles teaches changing the location of the object on the network in order to move the object across the network (for example, in one embodiment the introductory question/clue set for a game may inform the participants that the question will be related in some way to a particular book (identified in a clever way, perhaps not readily apparent to all participants...By visiting the Amazon.com Web site and searching for the subject book, the participants are required to become familiar with that site in an effort to locate the answer...Then, by clicking on a hidden (or not) hyperlink on that page of the Amazon.com site (e.g., a hyperlink hidden behind an image of the subject book or perhaps prominently displayed on the page if the advertiser so chooses) the participant is

Art Unit: 2155

returned to the game site – see Miles, col. 10, lines 14-49). This renders the rejection proper, and thus rejection stands.

41. ***Applicant Argues:*** Applicant states “The combination of Miles and Kay fails to disclose a link setting means for setting a link in a web page to move the object.”

In Response: The examiner respectfully submits that the combination of Miles and Kay discloses a link setting means, for setting a link in a web page stored at a web site on the network (when activated, the button icon will send the customer via a link to a separate page or window where an order form will be provided) in order to move the object (the button icon may be implanted or overlayed on the web page at a single location, or at a plurality of locations – see Kay, page 3, line 25 – page 4, line 27). This renders the rejection proper, and thus rejection stands.

42. ***Applicant Argues:*** Applicant states “The combination of Miles and Kay fails to disclose an object, capable of being selected by the user (Miles, col. 10, lines 45-49) in order to provide a reward for the user (), which moves from a predetermined web page to another web page, as described above in regard to claim 1 ().”

In Response: The examiner respectfully submits that the combination of Miles and Kay teaches an object, capable of being selected by the user (by clicking a hidden (or not)

hyperlink on that page of the Amazon.com site (e.g., a hyperlink hidden behind an image of the subject book or perhaps prominently displayed on the page if the advertiser so chooses) the participant is returned to the game site – see Miles, col. 10, lines 45-49) in order to provide a reward for the user (this sort of dialog can continue until all of the questions for a particular game have been answered, at which time a participant may be congratulated for his/her efforts and perhaps later notified (e.g., by electronic mail) at a later time of any prizes won – see Miles, col. 11, lines 1-5), which moves from a predetermined web page to another web page, as described above in regard to claim 1 (the button icon may be implanted or overlayed on the web page at a single location, or at a plurality of locations – see Kay, page 3, line 25 – page 4, line 27).” This renders the rejection proper, and thus rejection stands.

43. ***Applicant Argues:*** Applicant states “The combination of Miles and Kay fails to disclose a process for moving the object to another web page when a user browses the specific web page.”

In Response: The examiner respectfully submits that the combination of Miles and Kay teaches moving the object to another web page (the button icon may be implanted or overlayed on the web page at a single location, or at a plurality of locations) when a user browses the specific web page (when activated, the button icon will send the customer via a link to a separate page or window where an order form will be provided – see Kay, page 3, line 25 – page 4, line 27). This renders the rejection proper, and thus rejection stands.

44. ***Applicant Argues:*** Applicant states “The combination of Miles and Kay fails to disclose the incorporation of the object into the specific web site at a different location after the object has been selected by the user. Further, the combination of Miles and Kay fails to disclose that the information concerning the location of the object, which is provided for the user, indicates the ease of which the object can be reached from the web page browsed by the user.”

In Response: The examiner respectfully submits that the combination of Miles and Kay teaches the incorporation of the object into the specific web site at a different location after the object has been selected by the user (by clicking a hidden (or not) hyperlink on that page of the Amazon.com site (e.g., a hyperlink hidden behind an image of the subject book or perhaps prominently displayed on the page if the advertiser so chooses) the participant is returned to the game site...If the participant submits the correct response, he or she is presented with the next answer/clue set and the process repeats – see Miles, col. 10 line 45 – col. 11, line 1). Further, the combination of Miles and Kay teaches the information concerning the location of the object, which is provided for the user, indicates the ease of which the object can be reached from the web page browsed by the user (the game’s degree of difficulty can be increased or decreased in by providing harder or easier clues – see Miles, col. 15, lines 59-61).

Art Unit: 2155

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2155

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
March 8, 2006


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER